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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,722	03/21/2001	Sylvain Chevreau	PF 980065	6135

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Joseph S Tripoli  
Thomson Multimedia Licensing Inc  
CN 5312  
Princeton, NJ 08543-0028

EXAMINER

PICH, PONNOREAY

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/787,722	<b>Applicant(s)</b> CHEVREAU ET AL.	
	<b>Examiner</b> Ponnoreay Pich	<b>Art Unit</b> 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 1 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

In the paper filed on 12/10/2004, applicant amended claims 1 and 9. Applicant also added claims 10-12. Claims 1-12 have been examined and are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The previous office action is incorporated by reference in its entirety.

#### ***Docketing***

Please note that the application has been redocketed to a different examiner. Please refer all future communications regarding this application to the examiner of record using the information supplied in the final section of the office action.

#### ***Response to Amendment***

Applicant's amendments filed on 12/10/2004 have been considered. The examiner withdraws the previous examiner's objections to the specification and 112, second paragraph rejections to the claims in light of the amendments and arguments.

#### ***Response to Arguments***

Applicant's arguments, filed 12/10/2004, with respect to claims 1-9 have been fully considered and are persuasive. The rejections of claims 1-9 have been withdrawn. However, new rejections are made below.

Applicant's arguments regarding claim 1 refer to Linnartz '518 not teaching or suggesting "delivering a permission or a prohibition to copy and/or to play said digital data as a function of the identification or otherwise of at least an encryption of said digital data and a watermarking of said digital data." The current examiner agrees that

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Linnartz '518 does not teach the above recited limitation. The examiner also withdraws the rejection for claims 2-8 as they depend on claim 1, thus contain a similar limitation. Applicant also argues that for claim 7, neither Linnartz '518 nor Linnartz '092 teaches "a conversion of the digital data into analog signals." The current examiner agrees and withdraws the rejection to claim 7 for that reason also. The examiner also withdraws the rejection for claim 9 in light of applicant's arguments and amendments.

The examiner notes that no other arguments were made by the applicant regarding the rejection of the limitations of the dependent claims which were not inherited from a parent claim, therefore the examiner assumes that the applicant agrees with the previous examiner that the rejection of those claim limitations were valid. The examiner will thus address amended limitations, limitations that were added, limitations that were incorrectly rejected in the last office action, and new claims.

### ***Specification***

The disclosure is objected to because of the following informalities: In the amendment entered by the applicant on 12/10/2004, the applicant amended the specification to include proper headings for each of the sections of the specification. However, as amended, the "Background of the Invention" and the "Description of the Related Art" headings are placed in the middle of a sentence. Applicant is advised to double check where applicant want these headings placed.

Appropriate correction is required.

### ***Claim Objections***

Claim 1 and 9 are objected to because of the following informalities:

1. As per claim 1, the examiner respectfully suggests that line 2 of claim 1 should instead recite "consisting of" instead of "consisting in".
2. As per claim 9, on p5, for both of the limitations which begin "a system for protection against...", the examiner believe that a translation error of some sort has occurred. Instead of "receiving signals," the examiner believes that perhaps the applicant meant to recite "signals received."

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

Claims 1-6, 8, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (US 6,314,518) in view of Cooperman et al (US 5,613,004).

#### **Claim 1:**

Linnartz discloses a method of protection against the copying of digital data stored on an information carrier consisting of delivering a permission or a prohibition to copy and/or to play said digital data as a function of the identification (abstract). Note that several items mentioned in the abstract can read on the identification—i.e. the watermark, physical mark, control signal, or a digital signature.

Linnartz does not explicitly disclose said delivering is otherwise at least a function of an encryption of said digital data and a watermarking of said digital data. However, Cooperman discloses a digital data protection method that uses encryption of said digital data and a watermarking of said digital data (col 3, lines 48-52 and col 5, lines 30-47).

In light of Cooperman's teachings it would have been obvious to one of ordinary skill at the time the applicant's invention was made to modify Linnartz's method according to the limitation recited in claim 1. One of ordinary skill would have been motivated to do so as Cooperman discloses that his teachings would allow for the determination of who owned the original digital data from which copies were made and hence determine responsibility for the copies (col 3, lines 53-58).

**Claims 2-6 and 8:**

As per claims 2-6 and 8, a previous office action discloses how Linnartz teaches the limitations recited in the claims.

**Claim 10:**

Linnartz further discloses wherein a permission or a prohibition to copy and/or to play said digital data is delivered as a further function of the identification of the identification of a recordable or non-recordable type of said information carrier (col 4, lines 16-20).

**Claim 11:**

Linnartz further discloses wherein a permission or a prohibition to copy and/or to play said digital data is delivered as a further function of the identification of the identification or not of a cryptographic signature accompanying said digital data (col 8, line 67-col 9, line 8).

**Claim 12:**

Linnartz further discloses wherein the prohibition of digital copying comprises a blocking of output of the digital data (col 4, lines 1-3).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (US 6,314,518) in view of Cooperman et al (US 5,613,004) and further in view of Ichinoi (US 6,266,477).

**Claim 7:**

Linnartz and Cooperman do not explicitly disclose:

1. A conversion of the digital data into analog signals.
2. A corruption of the analog signals if a prohibition of digital copying is delivered.

However, Ichinoi discloses:

1. A conversion of the digital data into analog signals (col 3, lines 4-7 and col 4, lines 19-30).
2. A corruption of the analog signals if a prohibition of digital copying is delivered (col 11, lines 21-35).

In light of Ichinoi's teachings, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the combination method of Linnartz and Cooperman according to the limitations recited in claim 7. One of ordinary skill would have been motivated to incorporate Ichinoi's teachings in which digital data is converted to analog signals as Ichinoi recognizes that there are still technology that consumers have which are analog in nature, therefore in

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the art, there exists a need that digital systems be backwards compatible with them (col 1, lines 23-33 and col 2, lines 13-18). Incorporating Ichinoi's teachings would satisfy this need for backwards compatibility. One of ordinary skill would have been motivated to incorporate Ichinoi's teachings of corrupting the analog signals if a prohibition of digital copying is delivered as it would prevent copying of protected material (col 11, lines 33-35).

***Allowable Subject Matter***

Claim 9 is allowed.

**Claim 9:**

As per claim 9, the examiner was not able to find in the prior art teaching or motivation for the limitation in which a system for protection against playing signals received from said detection means and generating a playing prohibition signal **when an encryption of said digital data has not been detected and a watermarking of said digital data has been detected by said detection means**. The examiner notes that there are teachings in which playing is prohibited when an encryption is detected and a watermarking has not been detected. However, no motivation exists for one of ordinary skill to use that teaching to arrive at the applicant's limitation of prohibiting playing when an encryption has not been detected and a watermarking is detected. Further, to do so would teach away from the prior art found.

***Conclusion***



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 8:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PP

  
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